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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,305	11/08/2001	Bruno Borsoi	P21570	5187
7055	7590	01/25/2006	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			PHAM, HUONG Q	
			ART UNIT	PAPER NUMBER
			3764	
DATE MAILED: 01/25/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/986,305

Applicant(s)

BORSOI, BRUNO

Examiner

Huong Q. Pham

Art Unit

3764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 25-40 is/are pending in the application.
- 4a) Of the above claim(s) 10-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 25-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 3-4, 8-9, 13-14, 16, 18-23, 25, 27-29, 30-36, 38-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Dachgruber et al (6,360,454).

As for claim 30, Dachgruber et al shows every claimed feature of the claims including an upper having a high portion and a low portion, the high portion adapted to extend higher than an ankle of a wearer and the low portion adapted to extend along an instep of the wearer, a frame 24 comprising a tibia support, an instep support, and a

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bending zone (figure 1) between the tibia and instep supports, said frame 24 being detachable from the boot to allow the wearer to wear and to use the boot without the frame; said bending zone of said frame having a flexibility adapted to allow bending of said tibia support in a bending direction relative to said instep support within a bending plane through a range of bending, said range of bending comprises an angle of movement of up to 45 degree, said frame further comprising at least one abutment 100, Or 98 comprising a pair of abutting edges within said bending zone joint (note the edges of references 100, 98, and note that the frame 24 can be bent at a predetermined angle where opposed edges of structure 100, 98 will limit to some degree further bending of the frame and joint. Note that the apertures 100 or the notches 98 have abutting surfaces :abutting surfaces are the side-edges of apertures 100 or of notches 98 , and when the device 24 of Dachgruber et al is flexed at certain degree, the abutting surfaces or edges are capable of having the function to limit flexion to some degree), said pair of opposed edges being movable in said bending direction from initial positions relative to each other to limiting positions in which said pair of opposed edges are not further movable in said bending direction to thereby define a maximum bending of the frame at an end of said range of bending in said bending direction, said frame having a rigidity, at least in said bending zone, sufficient to prevent said bending of said frame at said bending zone beyond said range of bending during use of the boot when said pair of opposed edges are in their limiting positions. As for claims 31, 32, note notch 98 or 100. As for claim 33, note insert 102. As for claim 34, note notch 98. As for claims 25, 36, note that frame 24 is substantially fixed to base 37 (figure 1) by hook 50 , and note

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column 4, lines 11-16. As for claims 27, 28, 38, note in figure 3 that the tip (reference # 46) is compressible and can absorb shock to some degree. As for claim 39, note pocket 45. As for claim 40, note tongue 22. As for claim 1, Dachgruber et al shows every claimed feature of the claim including a rigid frame 24 (figures 1, 3), one bending zone having at least one abutment 100 or 98 with oppose edges limiting the bending of the frame and the joint (note the edges of references 100, 98, and note that the frame 24 can be bent at a predetermined angle where opposed edges of structure 100, 98 will limit to some degree further bending of the frame and joint) . Note that the apertures 100 or the notches 98 have abutting surfaces (abutting surfaces are the side-edges of apertures 100 or of notches 98), and when the device 24 of Dachgruber et al is flexed at certain degree, the abutting surfaces or edges are capable of having the function to limit flexion to some degree. As for claim 3, note column 4, lines 11-16. As for claim 4, note insert 102. As for claim 13, note eyelets 90 in figure 7. As for claim 16, note column 4, lines 6-7. As for claims 20- 23, note notches 98 and inserts 102 .

Claims 1- 2, 4-5, 8-9, 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Rathmell (4,043, 059) .

Rathmell shows every claimed feature of the claims including a rigid frame (figure 1), one bending zone having an abutment 5 with opposed edges . As for claim 4, note the compressible material in figure 4 . As for claim 5, note supports 3, or supports 1, 2 in figure 1. As for claim 17, note that the supports 1, 2 are wider than the bending zone.

Claims 1-3 , 8-9 ,14, 17-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Filice (6,381,877).

As for claim 1, Filice shows every claimed feature of claim 1 including a rigid frame (figure 4, note that "rigid " is a relative term), one bending zone having at least one abutment 26 with oppose edges limiting the bending of the frame and the joint (note that the frame 24 can be bent at a predetermined angle where opposed edges of structure 26 will limit to some degree further bending of the frame and joint) . As for claim 2, note figure 5. As for claims 3, 18, note membrane 22, 24.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5- 7, 15- 16, 19-23, 25-40 are rejected under 35 U.S.C. 103 as being unpatentable over Dachgruber et al in view of Filice (6,381,877).

Note the comments above for the teachings of Dachgruber et al and Filice. Dachgruber et al teaches substantially claimed feature of the claims including a detachable additional frame 24 with a bending zone attachable to tongue 22 of a boot. Filice teaches the structure of a rigid frame 26 as recited , having a bending zone with at least one abutment with opposed edges (figure 4) limiting bending of the frame at a

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predetermined angle of bending (the angle of bending depends on and is controlled by the moment of the wearer, and note that Dachgruber et al teaches the angle), at least one beveled notch (note figure 5), a flexible and substantially inextensible membrane 22, 24 (figure 4) , wherein the frame has the thickness and supports (as recited in claims 30,37) . In view of the teaching of Filice , it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the frame 24 of Dachgruber et al with the frame of Filice in order to provide the desire stiffness or bending movement for the boot. As for claim 5, note the thickness of the bending zone of Filice. As for claims 6,7 note the shock absorbing element 23 or 25 inside a pocket of the device of Filice. As for claim 15, note that the provision of a recess in a shell of a footwear for accommodating toes of a wearer is well known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the device of Dachgruber et al with a recess for accommodating toes of a wearer (note Filice 's device). As for claim 16, note column 4, lines 6-7 of Dachgruber et al. As for claim 29, Dachgruber teaches this range of bending.

Applicant's arguments filed on 10/31/2005 have been fully considered but they are not persuasive. Note the comments and explanation relative to the claims above. Applicant argues that elements 98, 100, 102 are not abutments. The examiner disagrees. Note the comments relative to the claims above for the teaching of Dachgruber (note abutment 100, 102, or 98 of Dachgruber et al). Note that the edges of the apertures 100, or the edges of the notches 98 have abutting surfaces , and when

the device 24 of Dachgruber et al is allowed to flex at certain degree, the edges of the apertures or notches are abutted and therefore are capable of having the function of limiting or resisting flexion to some degree (note that in claim 1, the range of bending or angle is not recited) . Applicant argues that “ the stiffener 24 slides relative to the tongue”. Note column 4, lines 11-16 of Dachgruber et al (the recess 40 may be made substantially the same size as the tongue stiffener), and note that the frame or stiffener 24 is fixed to the base by hook 50. Note the flexible and inextensible membrane 22, 24 of Filice.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huong Q. Pham whose telephone number is (571) 272-4980. The examiner can normally be reached on 6:30 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on (571) 272 - 4887. The fax phone number for the organization where this application or proceeding is assigned is 571-272-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

January 11, 2006

A handwritten signature in black ink, appearing to read "Michael A. Brown", with a long horizontal flourish extending to the right.

MICHAEL A. BROWN
PRIMARY EXAMINER